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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,173	04/16/2004	Kanji Kirmoto	SIC-04-021	9874

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EXAMINER

WILLIAMS, THOMAS J

ART UNIT PAPER NUMBER

3683

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,173

Applicant(s)

KIRMOTO ET AL.

Examiner

Thomas J. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 11-15, 21-25 and 36-53 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 8-10, 16-20 and 26-35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Acknowledgment is made in the receipt of the oath filed April 16, 2004, the preliminary amendment filed April 16, 2004 and the information disclosure statement filed April 16, 2004.
2. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Reissue Applications

3. Claims 37-53 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Claim 37 omits limitations pertaining to the interior of the actuating mechanism, specifically “an input cam movably mounted within the caliper housing to move in a rotational direction about a longitudinal axis, but not in an axial direction, said input cam having a first camming surface with an axially extending guide member non-movably fixed thereto at said longitudinal axis, and an output cam movably mounted within said caliper housing to move in the axial direction in response to rotation of said input cam, but not in the rotational direction, said output cam having a second camming surface with an axially extending bore, said guide member being at least partially disposed within said bore to ensure smooth relative movement between said input and output cams”, added during prosecution of 09/531,570 (US 6,557,671) in the amendment dated November 8, 2002 to overcome the outstanding rejection in view of Kawaguchi (US 3,789,959).

The above limitations have been replaced with new limitations directed to an exterior portion of the actuating arm, specifically “wherein the actuated mechanism comprises an elongated actuating arm rotatably coupled to the caliper housing to cause the actuated mechanism to move the first friction member from the release position towards the braking position; and wherein the actuating arm has a curved surface with a first portion coincident with a cable clamp and a second portion that extends from the first portion towards the cable support so that the cable, when coupled to the cable clamp, approaches the guide surface from the opening in the cable support essentially tangent to the guide surface and is supported by the guide surface when the first friction member is in the release position”.

The omitted limitations relate to previously surrendered subject matter, and thus constitute a recapture rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 6, 7, 11-15, 21-25, 32 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,582,177 to Carre et al.

Re-claims 1 and 11, Carre et al. disclose in figure 1 a cable disc brake, comprising: a caliper housing (partially shown as 10, see also column 3 lines 4-20); a first friction member and second friction member as known with caliper disc brakes (not shown); an actuated mechanism

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22 is coupled to the caliper housing for moving the friction members into engagement with a rotor, the actuated mechanism includes: an input cam (interpreted as 16, the threaded surfaces are in functionally equivalent to camming surfaces) moves in a rotational direction yet is prevented from moving axially, the overall length of element 16 is broadly interpreted as an axially extending guide member; an output cam 18 is movably mounted with the caliper housing to move in the axial direction but not the rotational direction, cam 18 is provided with cooperating camming surfaces, the guide member is partially disposed within the output cam.

Re-claims 2, 3, 12 and 13, the guide member is interpreted as a pin.

Re-claims 6 and 14, the actuating mechanism further includes an actuating arm 22.

Re-claims 7 and 15, spring 42 biases the actuating arm to a release position.

Re-claims 21-23, see figure 1.

Re-claims 24 and 25, the input cam includes a bushing (see figure 1, note L-shaped element adjacent the shaft) mounted on the operating shaft of the input cam.

Re-claim 32, see figure 1, the rear section of element 10 functions as a cover.

Re-claim 36, see figure 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 37-45 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,647,475 to Le Deit et al. in view of US 4,582,177 to Carre et al.

Re-claims 37-40, Le Deit et al. teach a cable disc brake, comprising: a caliper housing 12, a cable support 44, a first friction member 20a and a second friction member 20b; an actuating mechanism 10 that moves the first friction member towards the second friction member for engaging a rotor 11; the actuating mechanism comprises an elongated actuation arm 32 coupled to the caliper housing to cause the mechanism to move the first friction member from the release position to the braking position. However, Le Deit et al. fail to teach the actuating arm having the specific structure as recited in claim 37, in particular the curved guide surface.

Carre et al. teach a cable actuated disc brake having an actuating arm with a curved guide surface with a first portion coincident with a cable clamp 58 and a second portion that extends from the first portion to a cable support, such that when the cable is coupled to the actuation arm, the cable approaches the guide surface from the cable support (in particular the support taught by Le Deit et al.) essentially tangent to the guide surface and is supported by the guide surface when the friction member is in the release position. Furthermore, Carre et al. teach that the curved guide surface formation of the actuation arm provides for an increase in torque exerted during rotation, see column 4 lines 61-64. It would have been obvious to one of ordinary skill in the art

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to have replaced the actuating arm of Le Deit et al. with the actuating arm taught by Carre et al., thus improving the overall brake performance of the cable actuated brake mechanism. With regards to claims 38-40, the guide surface is formed by a projection that extends towards the cable support (see figure 6); a radially outer portion extends towards the cable support, a radially inner portion extends away from the cable support, the radially inner portion is illustrated as a slight inwardly slanted surface; the projection is disposed in close proximity to a radially outermost portion of the arm.

Re-claims 41 and 42, see spring around the cable in figure 2.

Re-claims 43-45, see bolt 60, arm 44 is capable of being rotated relative to the caliper housing thus adjusting the biasing force of the spring.

Re-claim 47, see bolt 60.

Re-claims 48 and 49, see column 2 lines 37-40.

9. Claims 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Deit et al. in view of Carre et al. as applied to claim 37 above, and further in view of US 6,199,669 to Huang.

Re-claims 50-53, Le Deit et al. as modified by Carre et al. fail to teach the specifics of the disc brake when mounted to a front fork of a bicycle. Huang teaches a typical manner by which to mount a mechanical disc brake to a front fork of a bicycle. The caliper housing includes a first mounting flange with a first opening, a second mounting flange with a second opening, the first opening is above a rotational axis, the second opening is below the rotational axis, the cable support is disposed about the rotational axis, the guide surface (as taught in Carre et al.) would be rearwardly of the rotational axis, and the cable support is rearwardly of the rotational axis. It

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would have been obvious to one of ordinary skill to have utilized the teachings of Huang when having mounted the brake apparatus of Le Deit et al. as modified by Carre et al., on a front fork of a bicycle, thus utilizing the front fork as a means of protecting the brake assembly from frontal impact.

Allowable Subject Matter

10. Claims 4, 5, 8-10, 16-20, 26-31, 34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed April 16, 2004 have been fully considered but they are not persuasive. The applicant contends that a recapture rejection is unwarranted due to *B.E. Meyers & CO. v U.S.* 56 USPQ. 2d 1110 (US Ct.Fed.Cls. 2000). The examiner respectfully disagrees in light of *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001).

Once a patent is obtained by adding a limitation to the claims to define over the art, that limitation, or a limitation related to that limitation, must remain in the claims. This situation applies to the instant application. The applicant willingly amended the patent claims to define over the art of record. As such the limitations added by amendment must remain in any reissue claims. Thus it is the opinion of the examiner that the omitted limitations relate to subject matter previously surrendered by the applicant, impermissible recapture of the surrendered subject matter exists, therefore the recapture rejection is proper.

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosner teaches a curved guide surface cooperating with an actuating arm. Belart et al., Bergles, and Haraikawa et al. each teach a cable actuated disc brake.

13. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is 571-272-7128. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, can be reached at 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-6584.

TJW

August 9, 2005

THOMAS WILLIAMS
PATENT EXAMINER

Thom Williams

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8-15-05